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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,922	11/20/2001	James E. Satloff	SATLOFF 202-KFM	7797

7590

08/15/2003

Karl F. Milde, Jr., Esq.  
MILDE, HOFFBERG & MACKLIN, LLP  
Suite 460  
10 Bank Street  
White Plains, NY 10606

EXAMINER

LAYNO, BENJAMIN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/005,922

Applicant(s)

SATLOFF ET AL.

Examiner

Benjamin H. Layno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's arguments, filed 6/26/03, with respect to the rejection of claims 1-20 under 102(a) in view of Pinto have been fully considered and are persuasive.

Therefore, the 102(a) rejection in view of Pinto has been withdrawn. However, the Applicant's arguments filed 6/26/03, with respect to the rejections of claims 1-20 under 102(b) as anticipated by Mero, and 103 further in view of Pearson, Fernandes and Peppel have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-5, 7-9, 12-14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mero et al.

The Applicant is referred to the description of Mero et al. in the first Office action. Mero et al. also recites that "every game card sold is individually numbered, certain of the cards being **more or less rare** than the others", see abstract, also see col. 9, lines 24-31. Thus, these rare cards are clearly a limited set of trading cards.

In regard to claim 1(d) and (e), Mero et al. recites that "On-line play will be facilitated by a database suitable for tracking and registering all on-line players and their respective game cards col. 8, lines 56-58. Mero et al. also recites that "Additional cards may be available through special releases, etc. Thus, players can collect rare cards that possess individual an unique powers and build up their own deck", col 9, lines 25-27. Thus, as players collect rare cards, the players register these rare cards on-line to update current information about each game play related feature. Furthermore, as

player's build their own deck with rare cards, the players advance their status in the game.

***Claim Rejections - 35 USC § 103***

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al.

The Applicant is referred to the first Office action.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of Pearson et al.

The Applicant is referred to the first Office action.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of Fernandes.

The Applicant is referred to the first Office action.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of (Pearson et al. or Peppel).

The Applicant is referred to the first Office action.

***Response to Arguments***

In the Applicant's remarks, the Applicant has argued that Mero et al. discloses a role playing board game which has no basis at all in reality. Thus, there can be no "current information about each game related feature in play" nor "advancing status of the game....". Mero's cards having nothing to do with real world sports figures.

The Examiner takes the position that claims 1-14 and 17-20 **do not** recite that the game is based on reality. These claims also **do not** recite that the indicia on the cards relate to real world sports figures.

Furthermore, the Applicant has argued that Pearson et al., Fernandez and Peppel teach the concept of registering trading cards with a game service provided, and advancing the status of the game in accordance with current information about such game related features and then changing selected ones of the cards in an attempt to improve the chances of winning the game.

The Examiner takes the position that this argument amounts to attacking the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

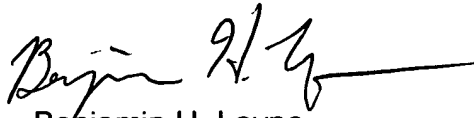
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl  
August 14, 2003